

## **REMARKS**

Upon entry of the present amendment, Claims 1-18 are pending in the application, of which, Claims 1, 5, and 13 are independent. New claims 13-18 are being added by the present amendment.

The above-identified Office Action has been reviewed, the references carefully considered, and the Examiner's comments carefully weighed. In view thereof, the present Amendment is submitted. It is contended that by the present amendment, all bases of rejection set forth in the Office Action have been traversed and overcome. Accordingly, reconsideration and withdrawal of the rejection is respectfully requested.

## **DISCUSSION**

### **Drawing Objections**

In item 1 of the above-identified Office Action, the Examiner objected to the drawings as including reference numbers and characters not specified in the description section.

In the present amendment, this objection has been overcome by amendments to the specification to add reference numbers C, D, and 19b, and by amending Figure 1 of the drawings to remove reference character B therefrom.

### **Amendments to the Specification**

In item 2 of the above-identified Office Action, the Examiner objected to the specification due to a spelling error in which the word "drum" was misspelled as "dram".

In the present amendment, this objection has been overcome by amendments to the specification to correct the error.

### **Section 102 Considerations**

In item 3 of the above-identified Office Action, the Examiner rejected claims 1, 2, 5-8 and 11 under 35 USC 102(b) as anticipated by Roulliard (4,903,436).

Applicant disagrees with, and traverses this ground of rejection, and requests reconsideration and withdrawal thereof.

### The Standard for Anticipation

In the case of *Motorola, Inc. v. Interdigital Technology Corp.*, 121 F. 3d 1461 (CAFC 1997), the Court of Appeals for the Federal Circuit stated:

**“For a prior art reference to anticipate a claim, the reference must disclose each and every element of the claim with sufficient clarity to prove its existence in the prior art (citation omitted). ‘The (prior art) reference must describe the applicant’s claimed invention sufficiently to have placed a person of ordinary skill in the field of the invention in possession of it’ (citations omitted). Although this disclosure requirement presupposes the knowledge of one skilled in the art of the claimed invention, that presumed knowledge does not grant a license to read into the prior art reference teachings that are not there.”**

The above-quoted passage is consistent with many previous cases of the Federal Circuit and with MPEP 2131, which reiterate the rule that **in order to anticipate a claim, a reference must teach every element of the claim.**

Applicant respectfully submits that Rouillard does not disclose each and every element of applicant’s claimed invention.

Specifically, Rouillard does not disclose (or suggest) a runner which is bonded to the window, as recited in claim 1, but instead discloses passing a portion of the runner 2e, 2d through a throughhole 9 in the window so that the exterior portion of the runner snap fits into the cabin side portion of the runner (col. 1 lines 64-68). The structure disclosed by Rouillard can not be interpreted as “bonded” according to the generally understood meaning of this word, which includes use of an adhesive to joint two members.

As regards claims 1 and 5, Rouillard teaches a runner which surrounds the side (vertical) edge of the window so as to extend on both the cabin side and the exterior side of the window.

As regards claim 2, the Examiner states that Rouillard discloses a dimension in the ups and downs direction of the junction is larger than the dimension in the fore and rear directions in Figure 1. Applicant disagrees with the Examiner about this matter, since Figure 1 of Rouillard is a cross sectional representation showing a front-to-rear dimension, and thus a comparison with the ups-downs dimension cannot be made. The disclosure of Rouillard is silent as to this

dimension. Because the runner of Rouillard is fixed to the window by a passing a portion 2e, 2d of the runner through a through hole 9 in the window, there is no reason to provide Rouillard with a large dimension in the up-down direction. Thus, applicant submits that claim 2 is not anticipated by Rouillard.

In contrast to the teachings of the references, in the apparatus according to the applicant's invention, only one side (vehicle cabin side) surface of the window glass is provided with the window runner, and the ups-and-downs direction's dimension of junction of the window runner is larger than the fore-and-rear direction's dimension.

This arrangement provides a sufficient bonding strength between the window glass and the junction, and substantially prevents the junction from detaching from the window glass.

This is because the bonding strength given from the ups-and-downs direction's dimension of junction exceeds the momentum force caused by the ups-and-downs direction's movement of the window glass.

Additionally, since the window runner is not provided on the outer side surface of the window glass, the appearance (design) of the vehicle is never spoiled. This feature of the appearance is not taught in the references.

#### Amendments to the Claims

In the present amendment, independent claim 1 has been amended to specify that the window runner is adhesively fixed or adhesively bonded to the window glass. This limitation does not add any new matter to the application, since it is fully supported by the specification, such as, for example, paragraphs 034 and 041.

The window runner of Rouillard is not adhesively bonded to the window glass, but instead, is attached to the glass by passing through a hole formed in the glass and being fastened back on itself.

Claim 5 has been amended to add a limitation that the window runner is entirely disposed inboard of the exterior surface of the window glass. This limitation is not taught, suggested, nor rendered obvious by any of the references of record, considered either individually or in any reasonable combination thereof. This arrangement also enables a very attractive exterior surface of the vehicle, by allowing the window to be substantially flush with the exterior body surface.

Applicant respectfully submits that the rejection of claims 1, 2, 5-8 and 11 under 35 USC 102(b) as anticipated by Roulliard has been overcome by the present amendment.

#### The Plat Reference

In item 5 of the above-identified Office Action, the Examiner rejected claims 1-5 under 35 USC 102(b) as anticipated by Plat et al, French patent 2,681,819.

Applicant respectfully traverses the Examiner's rejection of claims 1-5 on this basis.

The device disclosed in FR 2681819 is significantly different from the applicant's claimed invention. This is because the supporting structure of this reference is used for resiliently supporting the fringe of the window glass, in order to secure the sealing between vehicle body and the window glass.

In contrast to the teaching of FR 2681819, the supporting structure of applicant's invention is provided for supporting the window glass with respect to the door, while enabling smooth sliding of the window glass.

Further, applicant respectfully submits that the amendments to Claim 1, discussed above, patentably distinguish over the teaching of Plat '819, as well as over Rouillard.

Claim 5 specifically requires that the window runner is fixed to the window glass from a vehicle cabin side. Applicant traverses the Examiner's rejection of claim 5 based on Plat '819, and requests reconsideration and withdrawal thereof. Further, claim 5 has been amended as noted above.

Although the Examiner asserts in item 5 of the the Office Action that Plat et al, French patent 2,681,819 discloses a window support structure in which a window runner is fixed to the window glass from a vehicle cabin side, applicant disagrees with, and traverses this assertion. Contrary to the Examiner's assertion, Plat fails to teach, disclose or suggest a window runner that is fixed to a window glass from a vehicle cabin side. Instead, as shown in Figure 2 of Plat, the window runner of Plat is located at the side edge of the window glass, between two panels thereof.

Therefore, applicant respectfully submits that the rejection of claims 1-5 under 35 USC 102(b) as anticipated by Plat et al, French patent 2,681,819 has been overcome by the present amendment.

In item 7 of the above-identified Office Action, the Examiner rejected claims 9, 10 and 12 under 35 USC 103(a) as unpatentable over Plat et al, French patent 2,681,819, in view of Jourdain et al, (U.S. patent 5,979,932). The failures and limitations of the Plat reference are discussed in the preceding section. As noted, Plat fails to teach, disclose or suggest a window runner that is fixed to a window glass from a vehicle cabin side. Instead, as shown in Figure 2 of Plat, the window runner of Plat is located at the side edge of the window glass, between two panels thereof.

Moreover, Neither Plat, Jourdain, nor any reasonable combination thereof teaches the limitations of claim 1, as amended, in which a window runner is adhesively fixed or adhesively bonded to the window glass.

While the Jourdain reference teaches a composite window panel including a plurality of layers laminated together, each of claims 9 and 12 is a dependent claim, incorporating all of the limitations of the base claim(s) from which it depends. Applicant respectfully suggests that, as currently amended, these claims are distinguishable from the references of record because of the limitations contained in the base claims thereof. Applicant has canceled claim 10 in the present amendment.

Applicant respectfully submits that the rejection of claims 9 and 12 under 35 USC 103(a) as unpatentable over Plat et al, French patent 2,681,819, in view of Jourdain et al. has been traversed and overcome.

### New Claims

Applicant is adding new claims 13-18 by the present amendment.

New claim 13 is similar to claim 1, with the added limitation of the connector portion as part of the claimed window runner. The connector portion, as claimed, extends between and operatively interconnects the junction and the engagement part of the window runner.

New claim 14 depends from claim 13, and requires a plurality of window runners arranged in two spaced apart, substantially linear arrays, proximate opposed side edges of the window glass.

New claim 15 depends from claim 13. Claim 15 specifies that the connector portion is a shaft having a smaller diameter than that of the junction, and requires the junction and the engagement part to each be substantially disc-shaped.

New claim 16 depends from claim 13, and adds the requirements of the laminated window glass structure thereto, with the junction of the window runner sandwiched between the first window piece and the second window piece, one side surface of the junction bonded to the first window piece, and the other side surface of the junction bonded to the second window piece.

New claim 17 depends from claim 13, and requires that a dimension in the ups-and-downs direction of the junction is larger than a dimension in the fore-and-rear direction of the junction.

New claim 18 also depends from claim 13. Claim 18 requires that the window glass has an exterior surface which is substantially flush with a body of the vehicle, and that the window runner is entirely disposed inboard of the exterior surface of the window glass.

Applicant respectfully submits that each of these new claims includes subject matter which patentably distinguishes over all prior art of which applicant is aware, whether considered individually or in any reasonable combination.

Applicant therefore requests allowance of new claims 13-18.

**Conclusion**

Applicant respectfully suggests that as presently amended, all of the pending claims are believed to be allowable.

It is applicant's contention that no possible reading of the references, either singly or in any reasonable combination, can be viewed as teaching applicant's claimed invention.

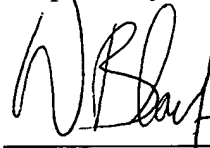
For all of the above mentioned reasons, applicant requests reconsideration and withdrawal of the rejection of record, and allowance of the pending claims.

Applicant respectfully submits that all of the above amendments are fully supported by the original application. Applicant also respectfully submits that the above amendments do not introduce any new matter into the application, since all of the subject matter thereof was expressly or inherently disclosed by the original specification.

Favorable consideration is respectfully requested.

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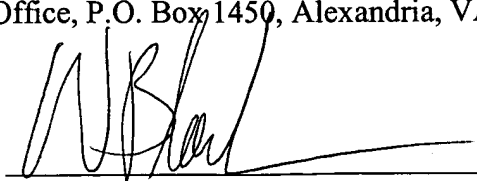
Respectfully submitted,



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**CERTIFICATE OF MAILING**

I hereby certify that this correspondence is being deposited with the U.S. postal Service, with appropriate first class postage thereon, and addressed to the Commissioner of Patents, U.S. Patent and Trademark Office, P.O. Box 1450, Alexandria, VA 22313 on December 9, 2004.



### **IN THE DRAWINGS**

Please amend Figures 1 and 6 of the drawings, according to the attached replacement sheets for Figures 1 and 6. In Figure 1, the reference character B and its associated lead line have been deleted, pursuant to the suggestion of the Examiner. In Figure 6, the words "PRIOR ART" have been added to more clearly indicate that the subject matter of the Figure is prior art included for discussion purposes.

Attachment:            Replacement Sheets  
                             Annotated Sheet Showing Changes to Figure 1

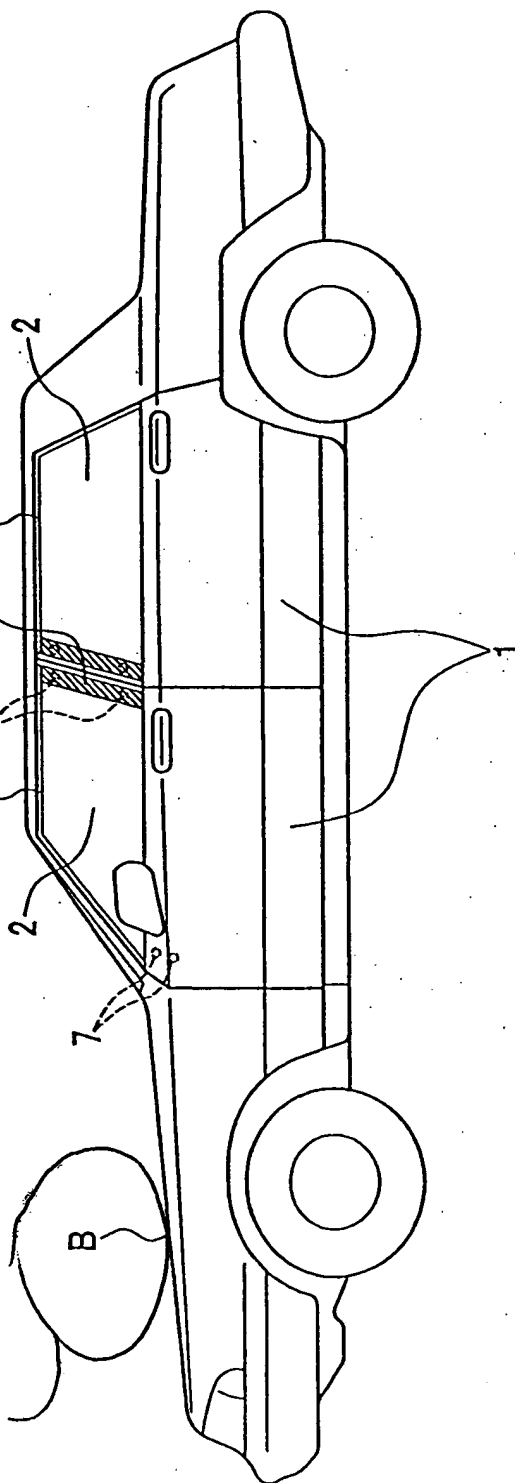




Application Serial No. 10/691,678  
Amendment Dated 09 December 2004  
Reply to Office Action of 14 September 2004  
Replacement Drawing Sheet

FIG.1

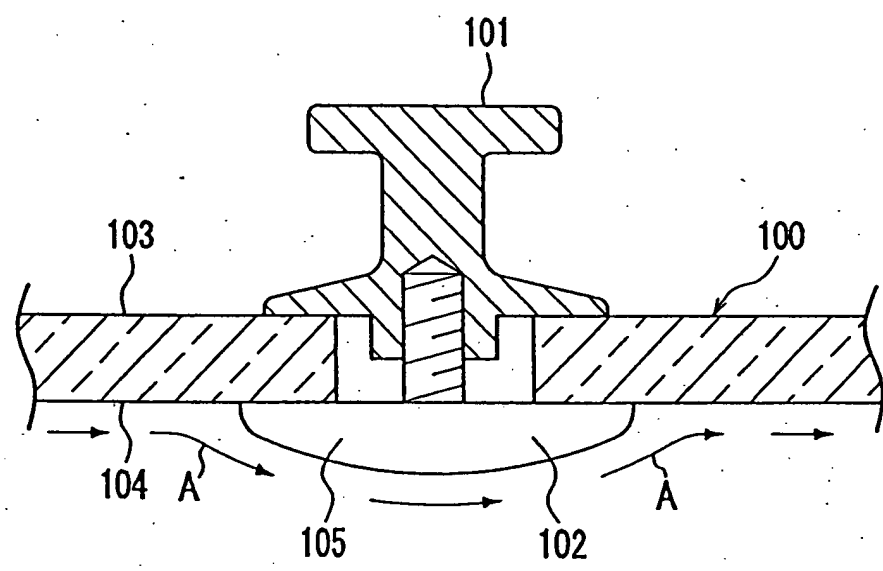
*Ref. character  
and lead line removed*



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Replacement Drawing Sheet

FIG. 6



PRIOR ART

Words have been added